

REMARKS

This Amendment is submitted with a Request for Continued Examination. The Official Action dated July 18, 2003 has been carefully considered. Accordingly, the following remarks are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

By the present Amendment, Claim 1 has been amended. Support for the amendment may be found at pages 17 and 18 of the specification. Claims 39 and 40 have been cancelled. Since these changes do not involve any introduction of new matter, entry is believed to be in order and is respectfully requested.

In the Official Action, the Examiner rejected claims 1-6, 9, 10, 12-17 and 39 under 35 U.S.C. §103 as being unpatentable over Brown et al. (U.S. Patent No. 6,071,566). The Examiner asserted that Brown et al. teach applying a mixture of silanes to a metal substrate in order to facilitate subsequent application of a paint layer. The Examiner noted that Brown et al. do not exemplify Applicant's composition, but teach using a two component aqueous mixture. The Examiner asserted it would be expected that the aqueous mixtures of silanes of Brown et al. would inherently contain some partially hydrolyzed groups. The Examiner asserted it would have been obvious to one of ordinary skill in the art to utilize a mixture of bis (trimethoxysilylpropyl) amine and vinyl silane as disclosed by Brown et al in order to effectively treat a metal substrate.

However, as will be set forth in detail below, it is submitted that the methods of claims 1-6, 9, 10, and 12-17 are non-obvious over and patentably distinguishable from the teachings of Brown et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

Brown et al. fail to teach or suggest the silane ratio of the presently amended claim 1. Specifically, Brown et al. disclose that the ratio of vinyl silanes to multi-silyl-functional

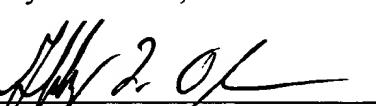
silanes ranges from 4:1 to 1:8. In contrast, the presently amended claims require that the ratio of vinyl silanes to bis-silyl aminosilanes is greater than 4 (claim 1).

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1971). It is well settled that to support a rejection under 35 U.S.C. § 103(a), a reference must provide an enabling public disclosure, i.e., it must place the claimed invention in the possession of the public, *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). In view of the failure of Brown et al. to teach, disclose or suggest a ratio of vinyl silanes to bis-silyl aminosilane of greater than 4, Brown et al. do not support a rejection of claims 1-6, 9, 10, and 12-17 under 35 U.S.C. §103. Reconsideration is respectfully requested.

In the Official Action, claim 40 was rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention. Claim 40 has now been cancelled, thereby mooting the Examiner's rejection of this claim.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§103 and 112, and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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